

Appl. No. : 10/017,920  
Filed : December 11, 2001

### REMARKS

In response to the Office Action mailed March 26, 2004, Applicant respectfully requests the Examiner to reconsider the above-captioned patent application in view of the foregoing amendments and the following comments. As a result of the amendments listed above, Claims 1-11, 15-17 and 19-31 remain pending. Claim 18 has been cancelled without prejudice or disclaimer, and Claims 6, 11, 15 and 19 have been amended. New Claims 23-31 have been added.

In the Office Action mailed March 26, 2004, the Examiner disposed of the claims as follows:

CLAIM NOS.	DISPOSITION/REJECTION		
	BASIS	PRIMARY REFERENCE	SECONDARY REFERENCE(S)
1, 3, 5, 7, 10, 20-21	102(e)	Lang US 6,231,603	n/a
1, 3-5, 7, 9, 10, 15-22	102(e)	Green US 6,558,420	n/a
2, 8	103(a)	Lang US 6,231,603	n/a
6, 11		Allowable if rewritten in independent form	

The Examiner also objected to an informality in the specification.

#### Claims 1, 7

Independent Claims 1 and 7 stand rejected as anticipated by each of Lang and Green. However, Applicant respectfully submits that neither Lang nor Green teaches “[a] posterior optic comprising a peripheral portion having positive refractive power and extending radially ... beyond the periphery of [a] refractive portion of [an] anterior optic, so that at least a portion of the light rays incident upon the posterior optic can bypass said refractive portion of said anterior optic,” as recited in Claim 1.

In rejecting Claim 1, the Examiner relies on an inspection of the drawings of Lang and Green to find disclosure therein of the claimed relative sizes of the anterior and posterior optics. Applicant respectfully submits that the rejection of Claim 1 is contrary to M.P.E.P. § 2125, which states that “proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale.” The same section also cites Federal Circuit case law

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(Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.2d 951 (Fed. Cir. 2000)) which is particularly relevant here.

In Hockerson, the patentee sought to enforce a patent directed to an athletic shoe. The inventive shoe featured a heel bisected by a central longitudinal groove, thus creating two peripheral “fins,” one on either side of the groove. At issue was whether the claims of the patent should be interpreted to cover only shoes featuring a central groove with a width that is narrower than the combined width of the “fins.” The patentee argued that such a narrow interpretation of the claims was incorrect because, inter alia, the specification contained figures depicting a groove that is wider than the fins. However, the Federal Circuit refused to draw any such inferences from the patent drawings, stating:

The [patent at issue] is devoid of any indication that the proportions of the groove and fins are drawn to scale. [The patentee's] argument thus hinges on an inference drawn from certain figures about the quantitative relationship between the respective widths of the groove and fins. Under our precedent, however, it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.

Neither Lang nor Green states whether their respective drawings are to-scale, and neither reference discusses the relative sizes of the optics in the specification. Accordingly, Applicant respectfully submits that independent Claim 1 is in condition for allowance over both Lang and Green.

Although independent Claim 7 recites a somewhat different combination of features than Claim 1, Applicant further submits that Claim 7 is in condition for allowance for at least the reasons stated above with regard to Claim 1.

#### Claim 15

Independent Claim 15 stands rejected as anticipated by Green. However, Applicant has amended Claim 15 to recite, inter alia, a posterior optic comprising a “peripheral portion extending radially away from said optical axis of said lens beyond the periphery of said anterior optic, so that at least a portion of the light rays incident upon the posterior optic can bypass said

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anterior optic." For reasons similar to those discussed above, the Green reference does not teach such an arrangement of the anterior and posterior optics. Accordingly, Applicant respectfully submits that amended Claim 15 is in condition for allowance over the prior art of record.

#### Claims 6, 11

The Examiner indicated that Claims 6 and 11 would be allowable if rewritten in independent form. Applicant has so rewritten Claims 6 and 11, and therefore submits that these claims are in condition for allowance.

#### Dependent Claims, New Claims

In view of the foregoing, Applicant respectfully submits that dependent Claims 2-5, 8-10, 16-17 and 19-22 are in condition for allowance, by virtue of their dependence from allowable base claims as well as their recitation of further novel and nonobvious combinations of features. Applicant also presents herein new Claims 23-31, which are also believed to be allowable over the prior art.

#### Specification

Applicant has amended the specification to address the informality noted by the Examiner.

#### Supplemental Information Disclosure Statement

Applicant submits herewith a Supplemental Information Disclosure Statement citing additional references for consideration by the Examiner.

#### Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowance is most earnestly solicited.

Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although amendments, deletions and cancellations have been made, no acquiescence or estoppel is or should be implied

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thereby. Rather, the amendments, deletions and cancellations are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Mark J. Kertz at (949) 721-6318 to resolve such issue(s) promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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